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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/568,146 | 09/25/2006 | David Alan Pears | HGX-012.01 | 7751 |

25181 7590 10/20/2010
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| EXAMINER |
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QIAN, YUN

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| ART UNIT | PAPER NUMBER |
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1732

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| NOTIFICATION DATE | DELIVERY MODE |
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10/20/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent@foleyhoag.com

| | | | |
|---|--------------------------------------|-------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/568,146 | Applicant(s) PEARS ET AL. | |
| | Examiner YUN QIAN | Art Unit 1732 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,4-6,9-12 and 35-37.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Melvin Curtis Mayes/
Supervisory Patent Examiner, Art Unit 1732

/YUN QIAN/
Examiner, Art Unit 1732

Continuation of Box 11. It does NOT place the application in condition for allowance because:

Applicant's arguments filed on October 12, 2010 have been considered but are not persuasive. The examiner would like to take this opportunity to address the Applicant's arguments.

Regarding rejection under 35 U.S.C. 112(1), applicants state the support for the catalyst and the ligands being "discrete", which can be found in page 1, page 9, page 11, page 12, page 14 and Examples 7 to 24. The transition metal and ligands do not form a conventional complex wherein the catalyst is bound to the ligand in the instant application (Remarks, pages 12-15)

The Examiner respectfully submits there is not any description explicitly and/or implicitly to support for the catalyst and ligands as being discrete entities and they are different from the conventional transition metal complexes in the instant Specification. The rejection is proper and stands in particular view MPEP 2163.03 "The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C. 112, first paragraph – description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate".

In response to applicant's argument the instant claims are directed to such microencapsulated catalyst-ligand complexes where the catalysts and ligands are encapsulated as discrete entities, i.e., they do not form a conventional complex wherein the catalyst is bound to the ligand (Remarks, page 13), the Examiner respectfully submits that the arguments of counsel can not take the place of evidence in the record, see MPEP 2145.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features, upon which applicant relies (i.e., post-adsorbed triphenylphosphine, the molar ratio of Pd/phosphine, oxidation states of Pd catalyst, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 1, 4-6, 9-12, and 35-37 rejected under 35 U.S.C. § 102(e) as being anticipated by Ley et al. (WO 03/006151), applicants argue the Examiner evidently accorded no weight to the limitation "the transition metal catalyst and the ligand encapsulated within the permeable polymer microcapsule shell are discrete" recited in claim 1, consistent with the concurrent rejection of that claim made under 35 U.S.C. § 112, first paragraph (*supra*). And Let et al. does not teach that the transition metal catalyst and the ligand encapsulated within the permeable polymer microcapsule shell are discrete, Ley et al. does not disclose each and every element of claim 1, as would be required for anticipation. Claims 4-6, 9-12, and 35-37 all depend, directly or indirectly, from claim 1. Accordingly, Ley et al. does not anticipate any of claims 1, 4-6, 9-12, and 35-37 (Remarks, page 16).

As set forth in the office action mailed on June 14, 2010 and discussed above, there is no clear definition of the word "discrete" in the instant application.

Furthermore, Ley et al. teaches a microencapsulated catalyst-ligand system comprising a catalyst and ligands microencapsulated within a permeable polymer microcapsule shell (claims 1-3).

Such microencapsulated catalyst system taught by Ley et al. comprises a catalyst and ligands (i.e. Wilkinson's catalysts $\text{RhCl}(\text{PPh}_3)_3$, Rh corresponds to applicant's transition metal rhodium and triphenylphosphine corresponds to applicant's ligand) microencapsulated within a permeable polymer microcapsule shell wherein the microcapsule shell is formed by interfacial polymerization (pages 9-10, claims 1-3).

In addition, the chiral phosphine ligand/transition metal catalyst system is also as evidenced by Burk et al (US 5,008,457) which is entirely incorporated by reference through Ley et al (page 9). Accordingly, Ley et al. anticipates the subject matter of the instant application.

As such, the rejection of claims 1, 4-6, 9-12, and 35-37 is proper and stands.